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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,675	11/28/2000	John K. Roberts	GEN10 P-333	6008

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EXAMINER
SEMBER, THOMAS M

ART UNIT	PAPER NUMBER
2875	

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/723,675	Roberts et al
Examiner	**Art Unit**
Thomas Sember	2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Oct 27, 2001*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-9, 11-70, 72, 73, 80-85, and 89-118* is/are pending in the application.

4a) Of the above, claim(s) *6-9, 15-18, 35-42, 50, 51, 72, 73, 80-85, and 89-118* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-5, 11-14, 19-34, 43-49, and 52-70* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

Detailed Action

1. Applicant's election with traverse of the species of figure 1 in Paper No. 10 is acknowledged. The applicant first points out that the examiner failed to identify which claims correspond to each of the species that were restricted. The examiner realizes that he failed to do this because it is the applicant's responsibility to elect the claims which correspond to each species identified by the examiner (see MPEP). In the examiner's election requirement, he properly listed each the species which he believed to be patentably distinct from the other. In the applicant's response to the election requirement, the applicant argues that the species are not mutually exclusive MPEP 806.04 (f). The examiner respectfully disagrees. Some of the claims recite features found in a first species but not in a second, and some of the claims recite features found in a second species that are not in the first.

The examiner's position in requiring an election of just one species is because the species are patentably distinct from each other which is an appropriate reason for restriction under MPEP 806.04(h). The applicant hasn't submitted any arguments or evidence to rebut the fact that the species are indeed patentably distinct. If the applicant wants all the claims examined, he must make a showing or state on record that the species are not patentably distinct. Additionally, the examination of all the

species would create a tremendous burden on the examiner. For example, alternative light sources such as LEDs, OLEDs, LEP, EL and photoluminescent light sources require searches in different classes such as 257 and 313 and several different subclasses in 362. Luminescent coatings used with light sources are also found in a different class 313 and several different subclasses in 362. Light sources encapsulated in a polymer material are found in class 313 and 362/267 and 362/310 and heat extraction elements are found in class 362/294 or 373. Furthermore, at least one of the applicants of this application is listed as part of the inventive entity that already has been granted two U.S. Patents, in addition to several other pending U.S. applications, which claim similar subject matter that is being claimed in this application. Certain claimed subject matter of the pending application needs to be separated out and compared with the claims of each of the patents and pending applications in which at least one inventor of this application is a common inventor. This further creates an additional on the examiner because it raises several double patenting and inventorship issues that still need to be addressed.

The applicant argues that species 1 is generic to other species. The examiner agrees that it is generic to some of the species but not all of them. To the extent that species 1 is generic to species 4, the applicant elects species 4 on page 14 of his response. Accordingly, all the claims drawn to a solid state light source and a

second photoluminescent light source that together form effective white light will be examined along with any claim generic to this species. The claims that read on the species 4 are claims 1-5, 11-14, 19-34, 43-49 and 52-70.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 11 and 67-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,132,072, claims 1-39 of U.S. Patent No. 5,803,072, claims 1-53, 55-63, 65 and 69-80 of application 09/604,056 and of claims 62-90 and 105-127 of application 09/153,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely using different terminology to claim the same invention.

Claims 1, 11, 67-70 are directed to the same invention as that of claims 1-53, 55-63, 65 and 69-80 of application 09/604,056 and of claims 62-90 and 105-127 of application 09/153,654. (applications have different inventive entities). The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claims 1, 11 and 67-70 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/604,056 and 09/148,375 which have a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Claim Rejections - 35 USC § 102

This application is a CIP of parent applications 09/148,375, 09/604,056 and 08/664,055. The applicant is reminded that he can only claim benefit back to the material that was disclosed in the prior applications. Since a photoluminescent light source combined with solid state light source to create white light was not taught in the previous applications, the examiner will use the filing date of 11/28/2000 as the earliest filing date for that claimed subject matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 11 and 67-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Turnbull et al ('072) or Turnbull et al ('579). These patents have different inventive entities.

Turnbull et al ('072) or Turnbull et al ('579) discloses a solid state first emitting light source with a wavelength less than about 530 nm when DC voltage is applied thereto. A second light source having a dominant wavelength of less than 625 nm is combined with first solid state light source so that light projected from the two sources overlap and form white light.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 11-14, 19-34, 43-49 and 52-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al Shimizu et al discloses a solid state first emitting light source with a wavelength less than about 530 nm when DC voltage is applied thereto. A second light source having a dominant wavelength of less than 625 nm is combined with first solid state light source so that light projected from the two sources overlap and form white light.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11-14, 19-34, 43-49, 52-70 are rejected under 35 U.S.C. 102(b) as being anticipated by (Bojarczuk, Butterworth or Polyan). (Bojarczuk, Butterworth or Polyan) discloses a solid state first emitting light source witha wavelength less than about 530 nm when DC voltage is applied thereto. A second light source having a dominant wavelength of less than 625 nm is combined with first solid state light source so that light projected from the two sources overlap and form white light. Polyan states at column 10, lines 39-42 that "the ELS will glow with a light the color of which is determined by combined properties of film layers 32 and 34 (e. g., if blue electroluminescent material 34 is used and yellow photoluminophor 32 is used, the glow light of the ELS will be close to white.".

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is (703)

308-1938. The examiner can normally be reached on Monday - Thursday from 8:00 AM - 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea, can be reached at (703) 305-4939. The fax phone number for this group is (703) 308-7724.

Any inquiries of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4900.

Thomas M. Sember

Primary Examiner
May 6, 2002